REMARKS

Applicant has carefully reviewed the office action dated September 8, 2004. This response is believed to address all grounds for rejection stated in the office action and place the application in a condition for allowance. Claims 1-37 remain pending in this application. All pending claims are rejected.

Change of Correspondence Address

Please direct all future communications with respect to this Application to Customer Number **24490**. Telephone calls should be made to the undersigned at (650) 248-7011. See attached grant of power of attorney by the Applicant/principal of the assignee of the patent application.

Change of Power of Attorney

A revocation of existing power of attorney and grant of new power of attorney is enclosed with this response. As stated therein, please revoke the power of attorney to the present counsel and make the undersigned attorney of record with all powers to prosecute this application. Please direct all future correspondence with respect to this application to Customer Number 24490.

Rejection of claims 1-37 under 35 U.S.C. § 102(b) as being anticipated by Cook (USP 5,727,950) (Agent based instruction system and method)

The Office Action rejected all the pending claims, claims 1-37, under 35 U.S.C. § 102(b) as being anticipated by Cook (USP 5,727,950). The Office Action discussed independent claim 1 and applied the discussion to all independent claims, thus rejecting all such claims for the same reason. Therefore this discussion focuses on claim 1, and later other independent claims.

To establish lack of novelty, one is required to prove that the reference met the limitations of the claims in the application. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003). Anticipation occurs if the prior art "explicitly or inherently discloses every limitation recited in the claims." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).

Claim 1 recites in part as follows:

> a display device coupled to the central processor unit,
>
> wherein said client computer device is adapted to act as a remote output device for one or more application programs running on said one or more remotely located server computers without the need for an execution environment on the client computer.

Thus, the portion of claim 1 recited above states that the client computer acts as a remote output device for one or more application programs running on one or more remote server computers *without the need for an execution environment on the client computer*. These features of the claim cannot be ignored. See *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532, 3 U.S.P.Q.2D (BNA) 1321, 1324 (Fed. Cir. 1987) (stating that one can not ignore a plethora of meaningful limitations). "[T]he dispositive question regarding anticipation [i]s whether one skilled in the art would reasonably understand or infer from the [prior art reference's] teaching" that *every claim element was disclosed in that single reference. In re Baxter Travenol Labs.*, 952 F.2d 388, 390, 21 U.S.P.Q.2d 1281, 1284 (Fed. Cir. 1991) (emphasis added). Patentability is determined for the invention as claimed, with all its features. It is improper to ignore explicit limitations from the claim in order to find the residue in the prior art. The Office Action did not show every element of the rejected claim was disclosed in the reference.

Moreover, recognizing the canon, "That which infringes if later anticipates if earlier," See *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573, 229 U.S.P.Q. (BNA) 561, 574 (Fed. Cir. 1986) (citing *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537, 32 L. Ed. 738, 9 S. Ct. 389 (1889)), the examiner is clearly not stating that the present claims would be infringed by the Cook reference because the present claims have the feature "remote output device for one or more application programs running on one or more remote server computers *without the need for an execution environment on the client computer*," which is not present in the Cook patent.

The Office Action misconstrued the claim and compared this description to a "virtual tutor" system described in a patent by Cook, et al. describing an "Agent based instruction system and method." Applicant respectfully traverses the rejection because the subject matter in Cook and the subject matter described in the instant application are

not only different, but the portions of Cook upon which the Office Action relied do not anticipate or render obvious the invention as claimed. In particular, the Office Action cited the following portion to argue that Cook anticipated the final element of claim 1:

> It is preferable to eliminate the need for permanent data storage devices, such as hard disc drives, by downloading all client software for each session. This allows the use of low cost 'network appliances' as student client computers. However, for those clients with lower speed network access asynchronous downloading can be used. Storage devices such as hard drives can be preferable for prefetching or caching of read-only software components in order to reduce start up time. To download 4 megabytes of software using, for example, a 28.8 Kbps modem takes over 20 minutes. In the case of caching on student client, standard version control methods known in the art are necessary to ensure that only up-to-date software and materials data are used. If an element is found to be out-of-date by querying a server, the current version is downloaded. The student data object is not be cached between sessions since it can be accessed from other client systems.

Cook, Col. 20, lines 59-67. Nowhere in the cited portion does Cook describe or suggest a client computer that can operate as a "remote output device for one or more application programs running on one or more remote server computers *without the need for an execution environment on the client computer*." The portion of Cook on which the Examiner relied does not disclose the elimination of an execution environment and rendering the client as a remote display device. To the extent Cook does not disclose, teach or suggest this feature of claim 1, it is respectfully submitted that claim 1 is patentable over the cited art. Nor does Cook motivate one of ordinary skill in the art to combine Cook with another reference to arrive at the instantly claimed invention. Reconsideration is respectfully requested.

The remaining independent claims have additional features or elements that the Office Action did not address. Nor does Cook suggest or disclose these additional elements or features. For example, Claim 16 recites a "compound request", a second

component to receive a "compound request" and a third component configured to ... update a display state of the client computer (Emphasis added):

> 16. An apparatus comprising:
>
> a client computer configured to fit in a person's hand, comprising:
>
> a central processor unit;
>
> memory device coupled to the central processor unit, said memory being configured to store instructions to direct the central processing unit;
>
> input device coupled to the central processor unit;
>
> a communication device coupled to the central processor unit and adapted to establish a wireless communication link with one or more remotely located server computers;
>
> second component coupled to the memory device, said *second component configured to receive a compound request message from the server;*
>
> third component coupled to the memory device, said *third component configured to use the compound request message to update a display state of the client computer; and*
>
> a display device coupled to the central processor unit,
>
> wherein said client computer device is adapted to act as a remote output device for one or more application programs running on said one or more remotely located server computers over a wide-area mobile network without the need for an execution environment on the client computer.

Claim 29 recites that "the remote client is established as an input/output device for the server-run application." Cook does not disclose or claim this feature.

> 29. An apparatus comprising:
>
> a server computer, comprising:
>
> a central processor unit;

memory device coupled to the central processor unit, said memory being configured to store instructions to direct the central processing unit;

a communication device coupled to the central processor unit and adapted to establish a wireless communication link with one or more remotely located client computers; and

instructions stored in the memory device, said instructions configured to instruct the central processor unit to establish a session with a remote client over a wireless communication network, execute an application on the server computer, and establish a communication path with the remote client such that the remote client is established as an input/output device for the server-run application.

Independent claim 30 recites that an application program executing on a server computer establishes a session with a client computer, exports its display to and receives a user's input [from a client computer] via a wireless network, and construes the user's input at the server computer. This feature also is not disclosed in Cook.

30. A method of establishing a client-server communication, said method comprising the steps of:

establishing a session between the client and the server computer, said client and server computer being connected using a wireless network;

executing an application program on the server computer;

exporting display of the application program to the client;

receiving a user input at the server computer; and

construing the user's input at the server.

Because none of the features highlighted in the independent claims are disclosed in Cook, Applicant respectfully submits that all independent claims in the instant application are patentable over the cited art. Because the independent claims are patentable, all dependent claims are also patentable. Reconsideration is respectfully requested.

Dependent claims

The office action completely omitted any discussion of the dependent claims. An examination of a patent application does not end with the independent claims because dependent claims may be patentable even if independent claims are not patentable. Because the office action did not address the dependent claims, Applicant respectfully objects to the incomplete examination. In the alternative, because the dependent claims are not shown to be anticipated or rendered obvious in view of any reference or combination of references, Applicant requests a notice of allowance as to the dependent claims. The Federal Circuit Court of Appeals stated of such grouping of claims:

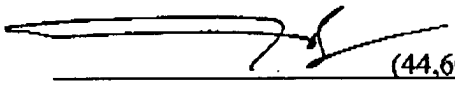
> This grouping of claims is contrary to law, which requires that "[e]ach claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; [and] dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim." 35 U.S.C. § 282 (2000). The burden of proving the invalidity of the claims was on the defendant. See, *e.g.*, *Abbott Labs. v. Geneva Pharms., Inc.*, 182 F.3d 1315, 1318, 51 U.S.P.Q.2d 1307, 1309 (Fed. Cir. 1999). To be sure, it is permissible to group claims together for disposition where resolution involves the same issues of validity; however, the justification for such grouping is possible only where those issues are substantially materially identical. Where claims differ in scope in an aspect material to the analysis, those claims must be addressed individually.

Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1372 (Fed. Cir. 2003). Because the claims are materially different here, they should either be individually examined or the dependent claims should be granted.

Conclusion

In view of the foregoing remarks, applicant believes that all rejected claims in the instant are in a condition for allowance. A clean copy of the pending claims is enclosed. Reconsideration and an early notice of allowance are respectfully solicited. No fee is due with this response.

Respectfully Submitted,



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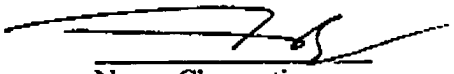
I certify that on November 15, 2004, I faxed this paper and all attachments to (703) 872-9306.



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